

REMARKS

Claims 1-33, 42-74 and 89-96 are pending in this application. Claims 34-41 and 75-88 have been canceled without prejudice to or disclaimer of the underlying subject matter. Claims 89-96 are new. No new matter is introduced. Reconsideration and prompt allowance of the claims are respectfully requested.

The Office Action at page 2 states that the oath or declaration is defective because the applicants' signatures are missing. On February 29, 2000, Applicants' filed a signed Declaration and Power of Attorney in response to a Notice to File Missing Parts. A copy of the previously filed declaration is attached. Applicants submit that the filing is complete.

Page 2 of the Office Action states that the Applicant is not entitled to the priority dates of U.S. Application No. 07/991,074 filed on Dec. 9, 1992 (hereafter, "the 074 application") and U.S. Application No. 08/160,194 filed Dec. 2, 1993 now U.S. Patent 5,990,927 (hereafter, "the '927 patent") because the cited applications fail to provide adequate support for the claims in the present application. The Office Action sets a new priority date for the current application in the form application 08/906,469 filed Aug. 5, 1997.

Applicants disagree with the Office Action. Applicants believe that sufficient support for the pending claims as required by 35 U.S.C. § 112 can be found in the disclosure of the 074 application as well as the disclosure of the '927 patent (collectively, "the priority documents"). The 074 application, at page 10, states that the system is capable of advertising products and services with on-screen television menus and, at page 43, provides that the types of information that can be sent via the program control signal includes menu or product information. In addition, the specification of the '074 application states that a hardware upgrade will enable a subscriber to download, store and read books known as electronic books. *See* '074 application specification at page 56. The specification of the '927 patent also provides that the types of information that can be sent via the program control signal includes menu or product information. *See* '927 patent, col. 13, lines 55-65 and col. 27, lines 5-11 and Fig. 19b. In addition the '927 patent specification provides access to promotional menus as well as access to services such as airline reservations services. *See, e.g.,* '927 patent, col. 36, line 20 to col. 38, lines 26 and Figs. 20a, 20b, 20c and 20d. These sections also teach the use of overlay menus as well as interactive services. The '927 specification also discloses electronic books and provides that books may be downloaded using the system. *See* '927 patent, col. 28, lines 10-31.

Based on the above-cited support for electronic books and access to products and services in the priority documents, Applicants submit that the pending application is entitled to the earlier priority dates of U.S. Application No. 07/991,074 filed on Dec. 9, 1992 (the 074 application) as well as U.S. Application No. 08/160,194 filed Dec. 2, 1993 now U.S. Patent 5,990,927 (the '927 patent). The disclosures of the priority documents contain adequate support to enable a person skilled in the art to practice the presently claimed invention as required by 35 U.S.C. § 112. For example, the priority documents adequately disclose to one of ordinary skill in the art a method for providing electronic commerce including:

presenting associated with the electronic book an identification of a product or service; receiving a user's selection of the product or service and a request to purchase the selected product or service; and performing a transaction to execute the purchase request,

as recited, among other features, in independent claim 1. The priority documents also adequately disclose to one of ordinary skill in the art an apparatus for providing electronic commerce including:

a presentation module for presenting associated with the electronic book an identification of a product or service; a receive module for receiving a user's selection of the product or service and a request to purchase the selected product or service; and an execution module for performing a transaction to execute the purchase request,

as recited, among other features, in independent claim 42. Therefore, the pending claims including independent claims 1 and 42 are entitled to the claimed priority dates of the priority documents. Specifically, the claims of the present application are entitled to at least the Dec. 2, 1993 priority date as well as the earlier Dec. 9, 1992 priority date.

The Office Action rejects claims 1-4, 6-9, 13-21, 24-27, 29-36, 39-45, 48-50, 54-62, 65-68, 70-77 and 80-88 under 35 U.S.C. §103(a) as being unpatentable over Escallon, US Patent No. 5,799,157 (hereafter, *Escallon*) in view of Westrope et al., US Patent No. 5,721,832 (hereafter, *Westrope*). The Office Action rejects claims 10-12, 22, 37, 51-53, 64, 78 and 84 under 35 U.S.C. §103(a) as being unpatentable over *Escallon* in view of *Westrope* and further in view of Mital, U.S. Patent No. 5,903,652 (hereafter, *Mital*). The Office Action rejects claims 38, 46 and 49 under 35 U.S.C. §103(a) as being unpatentable over *Escallon* in view of *Westrope* and further in view of Chelliah et al., US Patent No. 5,710,887 (hereafter, *Chelliah*).

Applicants traverse these rejections.

Based on the above discussion, Applicants respectfully submit that the applied references including *Escallon*, *Westrope*, *Mital* and *Chelliah* are not prior-art since the filing dates of the priority documents predate the filing date of each of the applied reference. Therefore, Applicants submit that the pending claims including independent claims 1 and 42 are in condition for allowance.

With respect to the dependent claims, assuming *Escallon* is prior-art, *Escallon* does not disclose or suggest, at least, a method for providing electronic commerce using an electronic book including:

- receiving from the user an offered price for the product or service;
- determining whether to accept the offered price; and
- selectively transmitting an indication of an acceptance of the offered price based upon the determining,

as recited, among other features, in dependent claim 20.

With respect to dependent claim 61, Applicants submit that *Escallon* does not disclose or suggest, at least, an execution module including:

- a module for receiving from the user an offered price for the product or service;
- a determination module for determining whether to accept the offered price; and
- a transmission module for selectively transmitting an indication of an acceptance of the offered price based upon the determining,

as recited , among other features, in dependent claim 61. Dependent claims 21 and 62 are directed to additional features associated with the “offered price.”

The Office Action at page 4 states that *Escallon* does not disclose the features of determining whether to accept the offered price and which criteria it was based upon. However the Office Action merely states that it would have been obvious to modify *Escallon* to include such features. Without citing any specific reference disclosing the claimed features such as “receiving from the user an offered price for the product or service” and “determining whether to accept the offered price,” the Office Action takes Official Notice that such features were known at the time of invention. Applicants traverse these rejections. Applicants request that the Office Action provides a reference citation that discloses the claimed features and provides motivation to combine the disclosed features with the applied art. MPEP § 2144.03 indicates that it would **not** be appropriate for the examiner to take official notice of facts without citing a prior art

reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known (emphasis in original).

Since the Office Action does not provide any reference disclosing the claimed features, Applicants submit that dependent claims 20, 21, 61 and 62 are in condition for allowance for these additional reasons. Applicants have added new claims 89-96 (claims 89 and 93 are independent) directed to features associated with the "offered price."

The other applied references including *Westrope*, *Mital* and *Chelliah* fail to overcome the deficiencies of *Escallon* described above. For example, none of the applied references, applied separately or in combination, disclose or suggest receiving an offered price for the product or service, determining whether to accept the offered price and selectively transmitting an indication accepting the offered price, as claimed.

Therefore, independent claims 20, 21, 61, 62 and new claims 89-96 are in condition for allowance for these additional reasons.

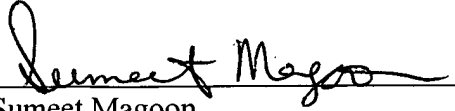
Claims 2-33, depend from independent claim 1, claims 43-74 depend from independent claim 42, claims 90-92 depend from independent claim 89 and claims 94-96 depend from independent claim 93. Therefore, claims 2-33, 43-74, 90-92 and 94-96 are allowable for the reasons stated above and for the additional features recited therein.

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: **February 24, 2004**



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Enclosure: Copy of Declaration and Power of
Attorney filed Feb. 29, 2000

20199

Dorsey & Whitney Filing Number

FEBRUARY 29, 2000

DATE OF FILING ENCLOSED PAPERS

Atty. Docket No.: 5268 (A NOTO/J HARROP)

Re: **ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES**

Application No.: 09/44,892

Filing Date: 17 NOVEMBER 1999

Patent No.:

Issue Date:

Opposition/Cancellation No.:

The following items/fees were received from Dorsey & Whitney, Washington, D.C., by the U.S. Patent & Trademark Office:

ITEMS

☒ Response to Notice to File Missing Parts Of Application
Filing Date Granted (PTO-1533)(Large Entity)

☒ Inventor Declaration and Power of Attorney

☒ Assignment w/Recordation Form Cover Sheet (From PTO-1595)

☐ PCT Request (5 pages) and PCT Fee Calculation Sheet

☐ New PCT Application (des. 41 pp; cls 11 pp; abstract 1p)

☐ Formal Drawings - Figures 1-18b on 46 sheets

☐ Power of Attorney (PCT Rule 90.4)

☐ Certificate of Correction

☐ Request for Certificate of Correction of Patent
For PTO Mistake (37 C.F.R. 1.322(a))

☐ Supplemental Information Disclosure Statement
IDS w/PTO-1449 (sheet(s) w/reference copies as listed in
IDS))

☐ Letter To Draftsperson

☐ Issue Fee Transmittal PTOL Form 85B (Rev. 05-96)

☐ Issue Fee Transmittal Letter

☐ Amendment Under 37 CFR § 1.312(a)

☐ Copy of Assignment Reel/Frame /

☐ New U.S. Patent/Design Application (pages of spec/claims)

☐ National Stage Application

☐ Translation of National Stage

☐ Priority Document - Cert. copy of Appln. # Dated

☐ Response

☐ Amendment

☐ Petition/Request for Extension of Time (1 month)

☐ Notice of Appeal

☐ Appeal Brief (in triplicate)

☐ Reply Brief (in triplicate)

☐ Request for Oral Hearing

☐ Confirmation of Hearing Petition

☐ Notice of Opposition

OTHER ITEMS

U.S. PTO FEES ENCLOSED

NO FEE REQUIRED

☐ Issue Fee

☐ Filing Fee

☒ Surcharge Fee (\$130.00 Large Entity)

☐ Additional Claim Fee

☒ Recordation/Indexing Fee (\$40.00)

☐ IDS Fee

☐ Extension Fee

☐ Notice of Appeal Fee

☐ Brief on Appeal Fee

☐ Oral Hearing Request Fee

☐ Petition Fee

\$130.00/\$40.00 TOTAL FEES ENCLOSED

Check Numbers #6161 and #6167

**RETURN DATE-STAMPED BLUE
SHEET TO:**

JANE STRAHL (202) 824-8851

200m 115486

**Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533)(Large Entity)**

Docket No.
5268

In Re Application Of: **John S. HENDRICKS, et al.**

Serial No.
09/441,892

Filing Date
November 17, 1999

Examiner
Not Assigned

Group Art Unit
2711

Invention: **ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

This is a response to the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533) mailed on
December 30, 1999
Date

Enclosed herewith for filing are the following:

- ☒ A copy of the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533). **(REQUIRED)**
- ☒ An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date.
- ☐ A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date.
- ☐ An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date.
- ☐ A verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the United States Patent and Trademark Office.
- ☒ Other (list):

Assignment

**Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533)(Large Entity)**

Docket No.
5268

In Re Application Of: **John S. HENDRICKS, et al.**

Serial No.
09/441,892

Filing Date
November 17, 1999

Examiner
Not Assigned

Group Art Unit
2711

Invention: **ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

☒ Completion of application fees as calculated below:

☐ Utility application filing fee

☐ Design application filing fee

☐ Total number of independent claims = _____

☐ Total number of claims = _____

☐ Multiple dependent claims

☒ Surcharge for late payment of filing fee and/or late filing of original declaration or oath **\$130.00**

☐ Petition and fee for filing by other than all the inventors or a person not the invention

☐ Fee for processing an application filed with a non-English language specification

☐ Fee for processing and retention of application

Total completion of application fees **\$130.00**

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the above-identified Notice to File Missing Parts of Application. The requested extension is as follows (check time period desired). If an additional time extension is required, please consider this a petition therefor.

☐ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

from: _____ until: _____
Date Date

Total time extension fees _____

Total fees due **\$130.00**

**Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533) (Large Entity)**

**Docket No.
5268**

In Re Application Of: **John S. HENDRICKS, et al.**

**Serial No.
09/441,892**

**Filing Date
November 17, 1999**

**Examiner
Not Assigned**

**Group Art Unit
2711**

Invention: ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

The fee of **\$130** is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **04-1425**
A duplicate copy of this sheet is enclosed.
- ☐ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No.
A duplicate copy of this sheet is enclosed.



Signature

Dated: February 29, 2000

**Aldo Noto, Reg. No. 35,628
DORSEY & WHITNEY LLP
1001 Pennsylvania Avenue, N.W.
Suite 300 South
Washington, D.C. 20006**

I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:



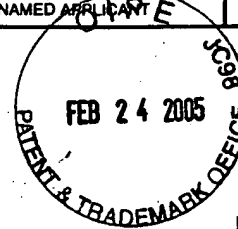
UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
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09/441,892 11/17/99 HENDRICKS

0212/1230



5268

JOHN K. HARROP
DORSEY & WHITNEY LLP
1001 PENNSYLVANIA AVENUE N.W.
SUITE 300 SOUTH
WASHINGTON DC 20004

NOT ASSIGNED

DATE MAILED: 2711

12/30/99

NOTICE TO FILE MISSING PARTS OF APPLICATION
Filing Date Granted

An Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). If any of items 1 or 3 through 5 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(e) of ☐ \$65.00 for a small entity in compliance with 37 CFR 1.27, or ☒ \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.

If all required items on this form are filed within the period set above, the total amount owed by applicant as a
☐ small entity (statement filed) ☒ non-small entity is \$ 130.00

- ☐ 1. The statutory basic filing fee is:
☐ missing.
☐ insufficient.
Applicant must submit \$_____ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).
- ☐ 2. The following additional claims fees are due:
\$_____ for _____ total claims over 20.
\$_____ for _____ independent claims over 3.
\$_____ for multiple dependent claim surcharge.
Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.
- ☒ 3. The oath or declaration:
☒ is missing or unsigned.
☐ does not cover the newly submitted items.
An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date is required.
- ☐ 4. The signature(s) to the oath or declaration is/are by a person other than inventor or person qualified under 37 CFR 1.42, 1.43 or 1.47.
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- ☐ 5. The signature of the following joint inventor(s) is missing from the oath or declaration:

An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

- ☐ 6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).
- ☐ 7. Your filing receipt was mailed in error because your check was returned without payment.
- ☐ 8. The application was filed in a language other than English.
Applicant must file a verified English translation of the application, the \$130.00 set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).
- ☐ 9. OTHER: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.